

ESTTA Tracking number: **ESTTA587042**

Filing date: **02/12/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Citigroup Inc.
Granted to Date of previous extension	02/12/2014
Address	399 Park Avenue New York, NY 10043 UNITED STATES

Attorney information	Joseph A. Calvaruso/Kristin S. Cornuelle Orrick, Herrington & Sutcliffe LLP 51 West 52nd Street New York, NY 10019 UNITED STATES jcalvaruso@orrick.com,kcornuelle@orrick.com,achen@orrick.com,ipprosecution@orrick.com,pvogel@orrick.com Phone:212-506-5000
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Applicant Information

Application No	85965545	Publication date	10/15/2013
Opposition Filing Date	02/12/2014	Opposition Period Ends	02/12/2014
Applicant	Capital One Financial Corporation 12077-0270 / Becky Dimmett Richmond, VA 23238 GERMANY		

Goods/Services Affected by Opposition

Class 036. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Banking and financing services

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	86085654	Application Date	10/08/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	USE CREDIT WISELY		

Design Mark	USE CREDIT WISELY
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 2002/12/04 First Use In Commerce: 2002/12/04 Banking and financing services

Attachments	86085654#TMSN.jpeg(bytes) Notice of Opposition USING CREDIT WISELY.pdf(167379 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Kristin S. Cornuelle/
Name	Joseph A. Calvaruso/Kristin S. Cornuelle
Date	02/12/2014

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 85/965,545
Published in the *Official Gazette* on October 15, 2013
Trademark: USING CREDIT WISELY

CITIGROUP INC.,

Opposer,

v.

CAPITAL ONE FINANCIAL
CORPORATION,

Applicant.

NOTICE OF OPPOSITION

Citigroup Inc. (“Opposer”), a Delaware corporation having an address at 399 Park Avenue, New York, New York, 10043, believes it will be damaged by registration of the mark USING CREDIT WISELY as shown in Serial No. 85/965,545 in International Class 36 and hereby opposes the same.

As grounds for opposition, Opposer alleges:

1. Opposer has obtained the necessary extensions of time in which to oppose the challenged trademark following its publication on October 15, 2013.

2. Capital One Financial Corporation (“Applicant”), has filed an application to register the mark USING CREDIT WISELY for “banking and financing services” in International Class 36 as evidenced by the publication of such mark in the *Official Gazette* on October 15, 2013.

3. Applicant is, upon information and belief, a Delaware corporation with an address at 15000 Capital One Drive, Richmond, Virginia, 23238-1119.

4. Opposer has used its USE CREDIT WISELY trademark in connection with the marketing and offering for sale of banking and financing services for many years in the United States.

5. Opposer is the owner of the trademark USE CREDIT WISELY for banking and financing services, and owner of the U.S. Trademark Application Serial No. 86/085,654 for the trademark USE CREDIT WISELY for “banking and financing services” in International Class 36.

6. Opposer has acquired common law rights in the trademark USE CREDIT WISELY in connection with its banking and financing services.

7. Opposer’s application for USE CREDIT WISELY was filed on October 8, 2013 based on use of the mark in commerce pursuant to Section 1(a) of the Lanham Act, 15 U.S.C. Section 1051(a).

8. Opposer has consistently and continually used the trademark USE CREDIT WISELY in interstate commerce in connection with banking and financing services since at least as early as December 4, 2002.

9. Applicant’s application for USING CREDIT WISELY was filed on June 20, 2013 based on a *bona fide* intent to use the mark in commerce pursuant to Section 1(b) of the Lanham Act, 15 U.S.C. Section 1051(b).

10. On information and belief, Opposer has priority over Applicant’s application because Opposer used its mark for over ten years prior to Applicant’s filing date of June 20, 2013.

11. Opposer has provided its banking and financing services under the USE CREDIT WISELY trademark throughout the United States since at least as early as December 2002, and has developed exceedingly valuable goodwill with respect to the USE CREDIT WISELY mark.

12. Opposer has made a substantial investment in advertising and promoting its USE CREDIT WISELY mark. By virtue of its efforts and the expenditure of considerable sums for promotional and advertising activities, and by virtue of the excellence of its services, Opposer,

with respect to its USE CREDIT WISELY mark, has gained extensive goodwill in the minds of the general public.

13. The trademark proposed for registration by Applicant, namely, USING CREDIT WISELY, is likely to be confused with Opposer's mark, USE CREDIT WISELY, because the marks are virtually identical in appearance, sound, meaning and overall commercial impression.

14. Applicant seeks to register USING CREDIT WISELY as a mark in connection with services that are identical to the services of Opposer, and such use so nearly resembles Opposer's use as to be likely to cause confusion, to cause mistake or to deceive consumers as to the origin, sponsorship and approval of Applicant's services within the meaning of 15 U.S.C. § 1052(d).

15. Applicant's services sold in connection with the USING CREDIT WISELY trademark will likely travel in the same channels of trade as Opposer's services sold under the USE CREDIT WISELY trademark; and said services will likely be purchased by the same class of consumers, thus causing consumers and the trade to wrongly associate Applicant's services with Opposer, and causing the purchasing public to assume that services marketed in connection with the mark USING CREDIT WISELY emanate from, or are approved, licensed, or sponsored by Opposer, have the same source as Opposer's services, or that Applicant is affiliated with Opposer.

16. If Applicant is permitted to use and register the USING CREDIT WISELY mark for the services as specified in the opposed application, confusion in trade resulting in damage and injury to Opposer would be caused and would result by reason of the fact that Applicant's mark is confusingly similar to Opposer's mark. Persons familiar with Opposer's USE CREDIT WISELY mark would be likely to buy Applicant's USING CREDIT WISELY services as services offered and sold by Opposer. Furthermore, any defect, objection, or fault found with Applicant's services marketed under the USING CREDIT WISELY mark would be likely to reflect upon and seriously injure the reputation that Opposer has established for its services offered under its USE CREDIT WISELY trademark.

17. If Applicant is granted the registration herein opposed, such registration would be a source of damage and injury to Opposer.

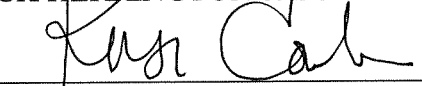
WHEREFORE, Opposer prays that the opposition be sustained and that the application be refused for registration.

Respectfully submitted,

ORRICK HERRINGTON & SUTCLIFFE LLP

Dated: February 12, 2014

By: _____



Joseph A. Calvaruso

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Kristin S. Cornuelle


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212-506-5000

CERTIFICATE OF SERVICE

I certify that a copy of the foregoing Notice of Opposition was served by First Class Mail, on February 12, 2014, on counsel for Applicant at the following address:

Becky Dimmett
Dennis Browne
Capital One Financial Corporation
15000 Capital One Drive
Richmond, Virginia 23238-1119

Dated: February 12, 2014

By: 
Kristin S. Cornuelle

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